



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Docket No. 0468FV.44178

In Re Application of:

Mosier, et al.

Serial No.: 09/921,238

Filed: August 2, 2001

For: Transesterification Composition of Fatty
Acid Esters, and Uses Thereof

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EXAMINER: Hamlin, Derrick G.

ART UNIT: 1751

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Aug. 10, 2005

Date

Sharanda Mozart

Sharanda Mozart

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below. This application has previously been **MADE SPECIAL**¹. In view of the special status and the failing health of one inventor, expedited review is requested.

The basis of this Request is the Examiner's omissions of one or more essential elements needed for a prima facie rejection for anticipation as related to independent claim 2 and the claims depending therefrom and the omission of one or more essential elements needed for a prima facie rejection for obviousness of claim 38, as well as no showing of proper motivation for

¹ Record Petition Decision of Granted to Make Special, 08-04-2004.

making a modification as proposed by the Examiner. Claim 114 was introduced in response to the suggestion of the Examiner in the Amendment after Final Rejection². No advisory action has been received to date. Consideration of all claims is requested.

Claim 2³ requires a composition including reaction products from a reaction of a ricinoleic acid with a compound containing a hydroxyl functional group in the presence of a phosphorus-containing acid, the reaction products including a transesterified fatty acid ester and a phosphorus-containing compound. The presence of a transesterified fatty acid ester is clearly a limitation of the composition in independent claim 2 of the current application. Applicants respectfully show that the Examiner has failed to point out in the Klein patent⁴ where a transesterified fatty acid ester is disclosed, either expressly or inherently. In summary, Klein teaches a dehydrated molecule derived from the starting castor oil whereas Applicant teaches a new chemical entity by virtue of a transesterification process. Klein is missing the transesterified fatty acid of claim 2 and those claims that depend therefrom. The word "transesterified" does not appear in the Klein reference.⁵ The specific reaction taught by Klein followed by mixing also does not result in a transesterified fatty acid ester.⁶ The Examiner initially summarized Klein and concludes the reference is anticipatory⁷. However, the summary clearly lacks the transesterified fatty acid ester element of claim 2. Claims 4, 16, and 19-23 depend from claim 2 and are not anticipated for the same reason.

² Entitled Response to Final Office Action Dated February 10, 2005, filed April 11, 2005

³ 2. A composition comprising reaction products from a reaction of a ricinoleic acid with a compound containing a hydroxyl functional group in the presence of a phosphorus-containing acid, the reaction products including a transesterified fatty acid ester and a phosphorus-containing compound.

⁴ US Patent No. 5,468,405

⁵ Declaration of Dr. Eric Simanek, paragraph 5, filed 4/11/2205; US Pat No 5,468,405

⁶ Id.

⁷ First Office Action, page 3, mailed 07/23/2004

While it is sufficient to identify only one element that is missing from the prior art, Applicants note that another element missing from Klein and not addressed by the Examiner is the results from the reaction of three specified components: ricinoleic acid with a compound containing a hydroxyl functional group in the presence of a phosphorus-containing acid. The Examiner has not pointed out where the results of Klein have a relation to the results created when all three of the reactants of claim 2 have been used in one reaction to create the composition. "No reaction of the dehydrated castor oil with alcohol is described by Klein."⁸ There is a clear absence of this element, namely, the product of the reaction of the three identified components together. The Examiner indicates that "the process steps have not been given patentable weight, as the applicant is claiming a composition that may be made by any process and not a process."⁹ The process is immaterial except as it affects the characteristics of the product, and for this reason cannot be read out of the claim. The Examiner has not satisfied a prima facie showing of anticipation for claim 2 on either of these elements.

The Examiner has not shown the elements of independent claim 38¹⁰ to support a prima facie case of obviousness. To support a rejection of claim 38 for obviousness, the Examiner refers back to the same recitation in Klein as for the anticipation rejection without additional information.¹¹ For the reasons noted above, there is a clear absence of the showing of a product similar to or the same as the composition of claim 38 created by reacting all three identified component. No specific information is provided by the Examiner that would support a

⁸ Declaration of Dr. Eric Simanek, paragraph 5.

⁹ Final Office Action, page 2, date 02/10/2005

¹⁰ 38. A composition resulting from the mixture of reactants, the reactants comprising: 25 mol %-36 mol % of ricinoleic acid ; 58 mol% - 62 mol% of alcohol; and 0.8-10 mol % phosphorus-containing acid.

¹¹ First Office Action, page 4, 7/23/2004

suggestion to combine the Klein reference with other unrelated chemical processes (i.e. transesterification) to obviate the current invention.¹² The Klein teachings, knowledge of one of ordinary skill in the art, and nature of the problem to be solved, as a whole, would not suggest doing so to those of ordinary skill in the art, as is required. Other than to try to piece together the Applicants' invention, the Examiner does not state why one with ordinary skill in the art would be willing to combine the Klein reference to provide the missing elements of the current invention, in particular, the resulting transesterified fatty acid ester. Even if the reference somehow could be combined or modified with the knowledge of one of ordinary skill in the art to produce the composition of the current invention, this still is not sufficient to establish a *prima facie* obviousness unless the prior art also suggests the desirability of the combination (i.e., the use of transesterified fatty acid ester instead of a dehydrated fatty acid). Not only is there no suggestion as to the desirability of the combination, discussed above, but also the combination would not in fact be desirable, as the teachings of Klein relate to reducing the KOH which teaches away from transesterification. See No Reasonable Expectation of Success¹³ While the Examiner states that the reference generally teaches that the compounds may be used, the Examiner does not specifically identify the motivation for drastically modifying the dehydration reaction of Klein followed by mixing with an alcohol to acquire the current applications composition resulting from a three-component reaction. As the Klein patent teaches away from the current claim 38 by decreasing the KOH number instead of maintaining or increasing it, the Examiner has failed to present a case as to the motivation or suggestion as to why one of ordinary skill in the art would modify Klein in a manner that is contrary to the stated goal of

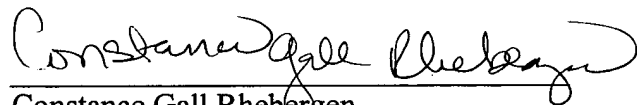
¹² First Office Action, page 4-5

¹³ Response to Final Office Action Dated February 10, 2005, mailed April 11, 2005

Klein to reduce the KOH number¹⁴. Furthermore, the Declaration of Fred Massey, filed Feb. 10, 2005 supports the surprising results obtained by the invention as claimed over non-transesterified castor oil.¹⁵ Therefore, claim 38 is believed to be non-obvious over Klein in view of one of ordinary skill in the art. Those claims depending from 38 are non-obvious for the same grounds.

Claim 114¹⁶ was added to specifically address the Examiner's request for a standard process claim. No action has been taken on this claim yet. All of the above information applies to this claim as well. Consideration of all claims pending is respectfully requested. I can be reached at (713) 221-3306.

Respectfully submitted,



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¹⁴ US Patent No. 5,468,405, Summary of the Invention

¹⁵ Declaration of Fred Massey, paragraph 2, filed April 11, 2005.

¹⁶ 114. A method of creating a phosphorus-containing composition comprising the steps of: reacting a fatty acid ester comprising ricinoleic acid with an alcohol in the presence of a phosphorus-containing acid such that the reaction products include a transesterified fatty acid ester and a phosphorus-containing compound.